



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
WASHINGTON, DC 20590
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,767	03/25/2003	Lucilla Stenias	00101000P	5928

2292 7590 03/25/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

DIBRINO, MARIANNE NMN

ART UNIT PAPER NUMBER

2644

DATE MAILED 03/25/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,703

Applicant(s)

STEINAA ET AL.

Examiner

DiBrino Marianne

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-83 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1644

DETAILED ACTION

1. Applicant's amendment filed 4/30/01 is acknowledged and has been entered.
2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

I. Claims 1-34, 54-63, drawn to a method of down regulating cells expressing a cell-associated polypeptide antigen in an animal comprising administering a polypeptide antigen analogue

II. Claims 35-47, drawn to a method of down regulating cells expressing a cell-associated polypeptide antigen in an animal comprising administering a microorganism or virus carrying a nucleic acid sequence which encodes a polypeptide antigen analogue

III. Claims 48-50, drawn to a method for selection of an immunogenic analogue of a cell-associated polypeptide analogue

IV. Claims 51-53, drawn to a method for the preparation of a cell producing an analogue of a cell-associated peptide antigen

V. Claims 64-66,73, drawn to an analogue of human PSM and composition thereof

VI. Claims 67-69, drawn to an analogue of human Her2

VII. Claims 70-72, drawn to an analogue of human/murine FGF8b

VIII. Claims 74-83, drawn to a nucleic acid, vector and transformed cell comprising the nucleic acid encoding a polypeptide analogue of human PSM and composition thereof and method of transforming the cell.

Art Unit: 1644

3. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 1 of the instant application does not provide a technical feature that is distinguished over the prior art, as evidenced by WO 95/05849 (reference provided by Applicant).

WO 95/05849 teaches a method for the modulation of self-proteins by inserting one or more foreign T cell epitopes into self-proteins (especially claim 1 of the reference). The skilled artisan at the time the invention was made was aware that self proteins are non-immunogenic and epitopes of the said proteins are presented by Class I MHC molecules expressed on the surface of antigen presenting cells (APC). Although WO 95/05849 teaches insertion of Th epitopes, one of ordinary skill in the art at the time the invention was made would have been aware that T cell help is also required for the production of CTL from CTL precursors. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have also included CTL epitopes in order to obtain an immune response that utilized both the humoral and cell-mediated arms of the system, i.e., the said method comprising effecting simultaneous presentation by an APC of a CTL epitope and a Th epitope.

Therefore, because claim 1 does not provide a special technical feature, the instant invention lacks an inventive step and therefore lacks Unity of Invention.

4. **If Applicant elects one of Groups V-VII**, Applicant is further required to (1) elect a single disclosed species (a specific analogue that includes a specific T cell epitope, for example, a specific SEQ ID NO) to which claims would be restricted if no generic claim is finally held to be allowable and (2) to list all claims readable thereon including those subsequently added.

These species are distinct because their structures are different.

5. **If Applicant elects one of Groups I-IV**, Applicant is further required to (1) elect a single disclosed species of polypeptide analogue (Group I or Group III), or nucleic acid molecule encoding a polypeptide analogue (Group II or Group IV) to be used in the claimed method, (a specific analogue that includes a specific T cell epitope, for example, a specific SEQ ID NO) to which claims would be restricted if no generic claim is finally held to be allowable and (2) to list all claims readable thereon including those subsequently added.

These species are distinct because their structures are different.

6. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Art Unit: 1644

7. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

9. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.


10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

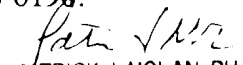
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne DiBrino whose telephone number is 703-308-0061. The examiner can normally be reached on Monday and Thursday from 11 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Marianne DiBrino, Ph.D.
Patent Examiner
Group 1640
Technology Center 1600
March 20, 2003


PATRICK J. NOLAN, PH.D.
PRIMARY EXAMINER
3/21/03